

REMARKS

I. Introduction

Claims 1 to 5, 8 and 9 are pending in the present application. In view of the following remarks, it is respectfully submitted that the present application is in condition for allowance, and reconsideration is respectfully requested.

II. Statement of Substance of Telephone Interview

Applicants thank the Examiner for the courtesies extended by Examiner Bhat during the course of the telephone interview conducted on October 31, 2006 between Examiner Bhat and Applicants' representative, Campbell C. Chiang (Reg. No. 59,518).

During the course of the telephone interview, no exhibit was shown and no demonstration was conducted.

During the course of the telephone interview, no specific claims were discussed.

During the course of the telephone interview, no "specific prior art" was discussed.

During the course of the telephone interview, no principal proposed amendments of a substantive nature were discussed.

During the course of the telephone interview, the general thrust of the principal arguments presented to Examiner Bhat was that the claims, as currently pending, satisfied the § 101 requirement of sufficiently producing a real life, real world, useful, concrete, and tangible result.

The general results or outcome of the telephone interview was a discussion of possible claim amendments and how the claims, as currently pending, satisfy the §101 subject matter requirement.

III. Allowable Subject Matter

Applicants note with appreciation the indication that claims 8 and 9 are allowed.

IV. Rejection of Claims 1 to 5 Under 35 U.S.C. § 101

Claims 1 to 5 were rejected under 35 U.S.C. § 101 as allegedly failing to produce a real life, real world, useful, concrete, and tangible result. Applicants respectfully disagree with the rejection for at least the following reasons.

As an initial matter, the Final Office Action completely fails to set forth a *prima facie* case of unpatentability. It is, of course, well settled that the Office bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). The Final Office Action does nothing more than set forth a number of form paragraphs followed by a request on page 2 for Applicants to “[p]lease view the following guidelines to overcome 35 U.S.C. 101 rejection made in this office action.” As stated in M.P.E.P. § 2106, “if USPTO personnel determine that it is more likely than not that the claimed subject matter falls outside all of the statutory categories, they must provide an explanation” (emphasis added). This, the Final Office Action does not in any manner do.

Thus, the Final Office Action plainly fails to set forth on the record why claims 1 to 5 are considered to not comply with the requirements of 35 U.S.C. § 101. As such, the present rejection should be withdrawn.

Notwithstanding the foregoing, Applicants respectfully submit that the present claims fully comply with the requirements of 35 U.S.C. § 101 for at least the following reasons.

As an initial matter, claims 1 to 5 relate to a method, which is squarely within one of the four categories set forth in 35 U.S.C. § 101, *i.e.*, a process. The Final Office Action in no manner provides any explanation whatsoever of whether or why claims 1 to 5 may be considered to fall outside of all of the statutory categories set forth in 35 U.S.C. § 101.

Furthermore, claims 1 to 5 are not within any of the three exceptions to the four statutory categories. That is, claims 1 to 5 do not constitute abstract ideas, laws of nature or natural phenomena. While it is stated in M.P.E.P. § 2106 that “abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods . . . employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be” (emphasis added). However, the Final Office Action in no manner provides any explanation whatsoever of whether or why claims 1 to 5 may be considered to be directed to abstract ideas, laws of nature or natural phenomena. To the extent that the Final Office Action may consider claims 1 to 5 to be directed to abstract ideas, laws of nature or natural phenomena, the method according to claims 1 to 5 sufficiently transforms an article or physical object to a different state or thing or otherwise sufficiently produces a useful, concrete and tangible result to constitute a practical application of an abstract idea, law of nature or natural phenomena.

Claims 1, 4 and 5, for example, recite that the method includes “successively applying a plurality of noise signals to [a] drive system as input signals.” A successive application of a plurality of noise signals to a drive system is a sufficient transformation or reduction of an article, *e.g.*, a drive system, to a different state or thing. As stated in M.P.E.P. § 2106, “[i]f USPTO personnel find such a transformation or reduction, USPTO personnel **shall end the inquiry** and **find that the claim meets the statutory requirements of 35 U.S.C. 101** (emphasis added).

To the extent that claims 1 to 5 may have been determined to not entail the transformation or reduction of an article, claims 1 to 5 sufficiently produce a useful, concrete and tangible result. As stated in M.P.E.P. § 2106, “the focus is not whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather on whether the final result achieved . . . is ‘useful, tangible, and concrete.’” For a claim to be “useful,” it must satisfy the utility requirement, *i.e.*, specific, substantial and credible utility must be provided. There is nothing in the record to indicate or suggest whether or why claims 1 to 5 may be considered to not satisfy the utility requirement. For a claim to satisfy the “tangible” requirement, the claim must recite more than a § 101 judicial exception. There is nothing in the record to indicate or suggest whether or why claims 1 to 5 may be considered to not satisfy the tangible requirement. For a claim to satisfy the “concrete” requirement, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. There is nothing in the record to indicate or suggest whether or why claims 1 to 5 may be considered to not satisfy the concrete requirement.

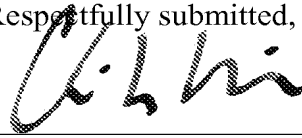
Having stepped through the analysis set forth in M.P.E.P. § 2106, it is plainly apparent that claims 1 to 5 fully constitute eligible subject matter. As such, withdrawal of this rejection is respectfully requested.

V. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

By:



Clifford A. Ulrich
Reg. No. 42,194

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646

Dated: